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Name of applicant, assignee, or Registered Rep.

Signature

August 23, 2004
Date

Patent
09/366,896

Attorney Docket
No. 42430-10030

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

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Patent Application

AUG 31 2004

Inventors Paul Norman Burgess
Serial No. 09/366,896
Filing Date August 4, 1999
Examiner W. Deane, Jr.
Group Art Unit 2642

Technology Center 2600

Title Method and Apparatus for Assigning Telephone Numbers

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SIR:

LETTER SUBMITTING REPLY BRIEF

Enclosed is the reply brief of Applicant Paul Norman Burgess for the above-captioned patent application. Please charge any required fees to deposit account 10-0460.

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Respectfully submitted,



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August 23, 2004

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

O I P E. S C I S
AUG 26 2004
PATENT & TRADEMARK OFFICE

In re Application of: :
Paul Norman Burgess :
Serial No.: 09/366,896 :
Filed: August 4, 1999 :
For: METHOD AND APPARATUS FOR ASSIGNING
TELEPHONE NUMBERS

x : Art Unit 2642

: Examiner William J. Deane, Jr.

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REPLY BRIEF

Technology Center 2600

The Appellant hereby submits a reply brief responding to the Examiner's Answer mailed June 30, 2004.

I. ARGUMENT

A. Leskinen Does Not Teach Inhibiting Incoming Calls by Omitting an Incoming Telephone Number.

The Examiner rejected all the pending claims 1-12 and 19-26 under 35 U.S.C. § 103(a) as being unpatentable over Leskinen alone or Leskinen in combination with Fougnies or Fukazawa. In the Examiner's Answer, the Examiner appears to concede that Leskinen does not explicitly teach or disclose a device that inhibits incoming calls by omitting an incoming telephone number. (Examiner's Answer, p. 6.) The Examiner argues that Leskinen, on a fair reading, implicitly teaches that the device inhibits incoming calls. The Appellant disagrees with the Examiner.

In support of the argument that Leskinen implicitly discloses or teaches inhibiting incoming calls, the Examiner raises the question of "How could one make a call under these [Leskinen] conditions?" The response is not complicated.

First, in all fairness, Leskinen is concerned with the assignment of a "user identification." That "user identification" is not the telephone number. *See* Leskinen, column 6, line 66 - column 7, line 59 (describing the user identification and noting the format of the user identification in the mobile identity frame of the GSM standard 04.08 version 4.11.0). The Examiner has merely equated the user identification with the telephone number in rejecting the Appellant's claims.

Second, it is clear that Leskinen does in fact contemplate the device disclosed therein as receiving incoming calls. In addition to the fact that normal operation and public telephone operation are contemplated, as discussed in Appellant's Brief, at pp. 5-6, Leskinen clearly indicates that the mobile station 1, which does not have a user identification, receives incoming calls. In particular, Leskinen states:

Although the invention was described above with reference to a mobile originated call 1, the invention can also be applied in a mobile terminated call from a second telecommunication terminal 22, 1' to the mobile station 1.

Leskinen, column 11, lines 48-51.

This passage from Leskinen clearly illustrates that incoming calls to the mobile station 1 are contemplated. That is, the mobile station 1 receives the "mobile terminated call from a second telecommunication terminal 22, 1'." How is that called placed and routed to mobile station 1? It is placed and properly routed using the incoming telephone number for mobile station 1. So clearly, incoming calls are not inhibited and a telephone number is not omitted, as required by the claims of the present invention.

As to the question raised by the Examiner: How could one make an incoming call under the conditions in Leskinen?. Well, one could just use the contemplated non-temporarily assigned telephone number. But even without that, as the Examiner notes in the Answer, the temporary “user identification” could be used, if it is used prior to a change in ID or a change in teleoperators. Moreover, the claims of the pending application require omitting an incoming telephone number, not merely inhibiting some calls.

Independent claim 1 requires, among other things, “omitting association of a telephone number with the unique equipment identifier, thereby inhibiting incoming calls.” Similarly, independent claim 11 requires a communication device “wherein no incoming call is receivable and outgoing calls are operably placed.” And, independent claim 12 recites a telecommunication switch “wherein at least one of the plurality of lines has no assigned telephone number for receiving incoming calls and has a capability to originate outgoing calls.” Independent claim 19 requires, among other things, “omitting association of a telephone number with the unique equipment identifier to inhibit incoming calls to the communications line.” Leskinen does not teach or disclose these novel features, explicitly, implicitly, inherently or otherwise. Hence, claims 1, 11, 12 and 19 are novel and not obvious in view of Leskinen. Claims 2-10 and 20-26, which ultimately depend from claim 1 and claim 19, respectively, are patentable for at least the reasons given above with respect to claim 1 and claim 19.

The Examiner has failed to set forth a *prima facie* case of obviousness in any rejections using Leskinen. In particular, there is no teaching, disclosure or suggestion in Leskinen to inhibit incoming calls by omitting a telephone number, as required by each of the independent claims of the present invention. Leskinen contemplates incoming calls to the devices disclosed therein. Therefore, all the claims are patentable and unobvious.

B. A *Prima Facie* Case of Obviousness Is Not Shown Because There Is No Motivation to Combine Leskinen With Either Fougnies or Fukuzawa.

The Examiner rejected claims 2-4, 6-8 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Leskinen in view of Fougnies. And, the Examiner rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Leskinen in view of Fukuzawa. Presumably, the Examiner rejected claims 20-23 and 24-25 under 35 U.S.C. § 103(a) as being unpatentable over Leskinen in view of Fougnies and rejected claim 26 under 35 U.S.C. § 103(a) as being unpatentable over Leskinen in view of Fukuzawa.¹ In addition to and as an alternative to the arguments for patentability given above, Appellant argued that claims 2-4, 6-8, 10, 20-23 and 24-25, are patentable, because a *prima facie* case of obviousness is lacking for these claims. In particular, Appellant argued there is no motivation to combine Leskinen with Fougnies or Fukuzawa.

In the Answer, the Examiner responds by arguing that Fukuzawa uses temporary telephone numbers and therefore conserves telephone numbers. The Examiner does not directly address Fougnies. With respect to Fukuzawa, the Examiner correctly notes that “conservation of telephone numbers via inhibiting incoming calls” is not directly at issue. The claims require omission of a telephone number. Fukuzawa provides temporary use of a telephone number for receiving calls. This teaches against omitting a telephone number for incoming calls.

Moreover, the Examiner still does not give a motivation to combine Leskinen with Fougnies or Fukuzawa.

¹ The Examiner did not explicitly specify the basis for the rejection of claims 19-26, other than to indicate those claims were rejected “in a like manner to the” other claims. In this appeal, due to the similarity in recitations, claims 20-26 are treated as being rejected like claims 2-8, respectively.

C. Conclusion

The Examiner's rejection of all claims using Leskinen is improper because Leskinen does not teach or suggest inhibiting incoming calls, as claimed. Additionally, and alternatively, the rejections of claims 2-4, 6-8, 10, 20-23 and 24-26 using Leskinen in combination with Fougnyes or Fukazawa are improper because there is no motivation to combine these references. Removal of the improper rejections places all pending claims in condition for allowance.

Respectfully submitted,



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